

DOCKET NO. 160557

PATENT

Serial No. 10/717,343

Response to Office Action dated Sept. 21, 2004

REMARKS

Claims 2, 3, 5-17, and 22-33 are in the case.

Claim 5 was rejected under 35 U. S. C. 112 for containing the phrase "under the conditions of use in making these paint formulations." This ground has been obviated by deleting the offending phrase.

The lack of antecedent basis rejections under 35 U. S. C. 112 of claims 14, 16, 24, and 29 have been obviated by providing antecedent basis for each term.

The rejection of claims 19-24, 27, 29, 30, and 32 were rejected under 35 U. S. C. 112 for being composition claims which referred to a process has been obviated by amending those claims to be product-by-process claims.

The rejection of claims 25 for being a composition claim referring to a process has been obviated by amending this claim into process format.

Claims 5, 8, 10, and 12-14 were rejected under 35 U.S.C. 102 as being anticipated by Coutelle et al. Claims 5, 8, 10 and 12 have been amended to depend on claim 23 which was not rejected under sec. 102, thereby obviating this ground of rejection. Claims 13 and 14 are drawn to a method of making a metallic paint formulation which comprises natural hectorite clay and metallic flakes, neither of which are disclosed in Coutelle et al.

Claims 2, 3, 7, 9, 15-17, 22, 23-25, 27-30, and 32 were rejected under 35 U.S.C. 103 as being obvious over Coutelle et al. According to the Office Action, Coutelle et al differ from the claimed invention in that they do not teach calcium hectorite or sodium hectorite. In fact, Coutelle et al differ in two critical regards: they do not teach natural hectorite and they do not teach automotive paint formulations having metallic flakes.

Applicants are claiming an automotive metallic paint formulation comprising at least 1% of beneficiated or unbeneficiated natural hectorite clay; from about 0.5 to 15 wt.%, based on the weight of the clay, of one or more phosphonate additives; metallic flakes selected from the group consisting of aluminum, copper and mixtures thereof; and water. Coutelle et al teach only

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synthetic phyllosilicates, including synthetic hectorite, with phosphoric acid esters and their salts as dispersion agents and dispersion stabilizers. Coutelle et al teach coating systems such as paints and varnishes, cosmetic and pharmaceutical preparations (such as creams and toothpastes), fertilizer suspensions, pesticide spray systems, undersealing compositions, bitumen emulsions, lubricating greases, polishing agents, printing inks, structural plasters, etc. With this product the rheology can be adjusted, in particular, its viscosity, stability (anti-settling effect, syneresis) and layer thickness (anti-sagging action). See col. 4, ll. 1-9. Automotive metallic paints with metallic flakes is a very special type of paint, of great commercial importance, which is not disclosed by Coutelle et al.

Applicants have discovered the unexpected advantage of natural hectorite versus synthetic hectorite in this special metal-containing automotive paints application area. Applicants disclosed the advantages of natural hectorite over synthetic hectorite in the specification at several places, including page 7, last paragraph, and in the comparative experiments starting at page 16, Example 2. These demonstrated advantages relate in general to metal control, solids level, and stability in metal-containing automotive-type paints. The need for metal control is not present in paints in general. Since it is only a problem in metal-containing paints, applicant's solution of using natural hectorite with phosphonate additives would not have been obvious.

Coutelle et al do not suggest the advantages of natural hectorite in metal containing paints discovered by applicants. There is nothing in Coutelle et al which would lead one skilled in the art to make automotive paint formulations containing metal particles with natural hectorite and phosphonate additives, and there is nothing in the prior art which would predict the advantageous results relating to metal control, solids level, and stability in metal-containing automotive-type paints which applicants invention provides.

Claims 1, 4, 5, 8, 10, and 12-14 were rejected under 35 U.S.C. 102(e) over three Ijdo et al publications. In fact, Ijdo et al U.S. Pat. Publ. 2002/0144630 was published Oct. 10, 2002, more than one year prior to the present application's filing date, and so it can not be sworn behind as suggested in the Office Action. Claims 1 and 4 have been cancelled and the other claims have

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been amended to require metal flakes selected from the group consisting of aluminum, copper, and mixtures thereof, which is not disclosed in Ijdo, thereby obviating this ground of rejection.

Claims 2, 3, 7, 9, 15-21, 23-25, 27-30, and 32 were rejected under 35 U.S.C. 103(a) over the three Ijdo et al publications. The Office Action found these claims to differ from Ijdo et al because calcium hectorite and sodium hectorite were not disclosed in Ijdo et al. However, all of the claims have been limited to that of claim 23 and therefore require the metal flakes discussed previously herein. Attention is directed to all of the experimental examples and discussion at pages 15-42 of the specification wherein the surprising and unexpected technical advantages of natural hectorite with phosphonate are demonstrated versus prior art metal control additives. The advantages of natural hectorite/phosphonate over the prior additives which are compared in the examples and tables would not have been obvious to those of normal skill in this art. Applicants did not invent the natural hectorite/phosphonate combination; that was disclosed in the prior art by Ijdo et al. However, the discovery of the very special results and advantages in the narrow field of automotive metallic paints was not taught or even suggested by a fair reading of Ijdo et al. Reconsideration and withdrawal of this ground of rejection is requested.

Claims 1-5, 7-21, 23-25, 27-30, and 32 were rejected over co-pending Ijdo et al application No. 10/620,617 on the ground of obviousness-type double patenting. Ijdo et al does not claim metal containing automotive paint formulations or methods of making them. Applicants have demonstrated unexpected results for such automotive paint formulations when compared to synthetic hectorite and other prior art additives previously used in the metal-containing automotive paint art, and so Ijdo et al claims a patentably distinct invention. See the arguments set forth in the previous paragraph regarding unobviousness under 35 U.S.C. 103 over the Ijdo et al patent publication which is the grandparent, with the same disclosure, as S.N. 10/620,617. The invention claimed in the present application is not obvious over the invention claimed, or even disclosed, by the cited Ijdo et al. Reconsideration and withdrawal of the double patenting rejection is urged.

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Applicants acknowledge with appreciation the indication of allowable subject matter in claims 6, 11, 22, 26, and 31. The rheological additive and alkali swellable-rheological additive limitations of these claims are separate grounds of patentability for these claims, but it is believed that the two independent claims, claim 23 drawn to an automotive metal-containing paint formulation, and claim 13 drawn to a method of making an automotive metal containing paint formulation, are also patentable. All of the present claims are dependent on these two claims.

For these reasons, applicants believe that all of the grounds of rejection should be withdrawn in view of the present amendments and arguments.

Respectfully Submitted,

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